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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,732	06/25/2001	William A. Mittelstadt	56733USA5A.002	2092
32692	7590	08/20/2004	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			RAGONESE, ANDREA M	
			ART UNIT	PAPER NUMBER
			3743	
DATE MAILED: 08/20/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/888,732	MITTELSTADT ET AL.	
	Examiner	Art Unit	
	Andrea M. Ragonese	3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,7-11,13-21,34-46,49-53 and 56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34-42 is/are allowed.
- 6) ☒ Claim(s) 1,3,7-11,13-21,43-46,49-53 and 56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. The timely response filed on May 10, 2004 has been entered. Examiner acknowledges that **claims 1, 3, 7-11, 13-21, 34-46, 49-53 and 56** are still pending. In addition, the examiner acknowledges that **claims 34-42** are allowed, as stated in Office action, mail date February 10, 2004.
2. Applicant's arguments, filed May 10, 2004, regarding the provisional nonstatutory double patenting rejection, have been fully considered but they are not persuasive. On page 2, Applicants state, "pursuant to M.P.E.P. § 804(I)(B), the examiner should withdraw the rejection and permit the instant application to issue as a patent." Further review of MPEP § 804(I)(B) determined that the provisional nonstatutory double patenting rejection as set forth in the Office action, mail date February 10, 2004, is still proper and is, therefore, made **FINAL**.
3. Based on MPEP § 804(I)(B), the presumption is made that a provisional nonstatutory double patenting rejection has been presented in **both** copending applications, which contain conflicting claims. Since a provisional nonstatutory double patenting rejection has only been made in the instant application, and there is no double patenting rejection present in US Application No. 09/888,943, then the ***provisional nonstatutory double patenting rejection will be maintained in the instant application***, until such time that a) a double patenting rejection involving the conflicting claims has been presented in the copending application; b) a terminal disclaimer disclaiming the terminal portion of any patent granted on this application which would

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extend beyond the expiration date of any patent granted on US Application No. 09/888,943 has been reviewed and is accepted; or c) elimination of such conflicting claims from all but one application has occurred.

4. Until such time, the provisional double patenting rejection will continue to be made by the examiner since this double patenting rejection is the only link between the two copending applications with conflicting claims that claim different inventions that are not patentably distinct from one another.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

6. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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7. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. **Claims 1, 3, 7-11, 13-21, 43-46, 49-53 and 56** are provisionally rejected under the judicially created doctrine of double patenting over claims 1-18 of copending Application No. 09/888,943. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

9. The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

- The copending application discloses a valve body, a frame, a valve opening, a valve seat and a valve flap having a plurality of support members (such as a rib). The valve flap has a contour shape and a portion of the contour shape of the valve flap is at least partially flattened when the valve flap contacts the valve seat. Furthermore, the copending application discloses that the valve flap comprises a first side and a second side, in which the valve contour varies between the first and second side. The valve flap has a compound curvature and the flap comprises a first and second end, wherein the valve contour varies between the first and second ends. The copending application further discloses that the valve seat is generally planar and the valve flap has a curvature that causes a bias of the valve flap toward the valve seat to

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provide a seal between the valve flap and the valve seat. The valve is an exhalation valve and an inhalation valve. The valve flap is removably attached to the valve body.

- Similarly the instant application claims a valve body, a frame, a valve opening, a valve seat and a valve flap having at least one rib. The valve flap has a contour shape and a portion of the contour shape of the valve flap is at least partially flattened when the valve flap contacts the valve seat. Furthermore, the instant application states that the valve flap thickness of a base part of the valve flap outside of the rib decreases when moving from first end to the second end. The instant application further discloses that the valve seat is generally planar and the valve flap has a curvature that causes a bias of the valve flap toward the valve seat to provide a seal between the valve flap and the valve seat. The valve is an exhalation valve and an inhalation valve. The valve flap is removably attached to the valve body.

10. Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Allowable Subject Matter

11. **Claims 34-42** are allowed.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

13. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Andrea M. Ragonese** whose telephone number is **703-306-4055**. The examiner can normally be reached on Monday through Friday from 8 am until 4:30 pm.

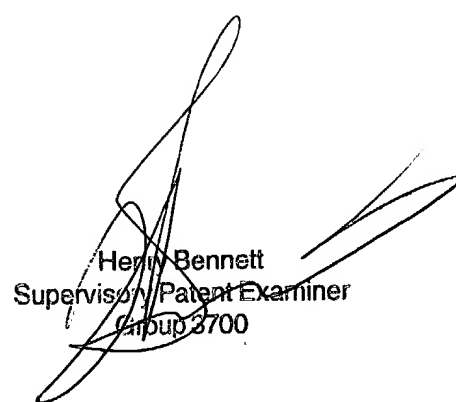
15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett can be reached on 703-308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AMR



Henry Bennett
Supervisory Patent Examiner
Group 3700